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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,023	02/18/2004	Thomas A. Findley	NE1.008	5413

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EXAMINER	
ROSEN, NICHOLAS D	
ART UNIT	**PAPER NUMBER**
3625	

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/782,023	FINDLEY, THOMAS A.	
	Examiner	Art Unit	
	Nicholas D. Rosen	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 February 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claims 1-3 have been examined.

Regarding Appeal Brief

The Appeal Brief filed April 16, 2004 has been considered, but is judged not proper to be filed under the circumstances, and therefore not subject to an Examiner's Answer. Applicant has attempted to begin the prosecution of the instant application with an Appeal Brief, but there are two barriers to considering it. First, although claims 1-3 were rejected in a parent case, they were cancelled from that parent case (Application 09/513,608, now U.S. Patent 6,714,919), and were therefore not under rejection at the time of the Appeal Brief. CFR § 1.191(c) states, "An appeal when taken must be taken from the rejection of all claims under rejection which the applicant or patent owner proposes to contest." Secondly, CFR § 1.191(a) states, "Every applicant . . . may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in § 1.117(b) within the time period provided under §§ 1.134 and 1.136." Applicant's notice of appeal was not filed within the time period provided since the rejections of the claims being contested, or even the allowance of application 09/513,608, and was therefore not timely. The substantial lapse in time meant that over a year had passed by for relevant patents or patent applications to be published, one or more of which might have been filed before Applicant's priority data, and provide even better grounds for rejection than the art previously relied upon (although, in point of fact, Examiner's update search did not find any such art superior to the combination already relied upon).

Now that Applicant's claims have been rejected in the present Office action, Applicant is at liberty to appeal.

Specification

The disclosure is objected to because of the following informalities: In line 6 of page 1, the reference to Application 09/513,608 should be updated to reflect that that parent application is now U.S. Patent 6,714,919.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tetro et al. (U.S. Patent 6,095,413) in view of Perlman (U.S. Patent 5,862,220). As per claim 1, Tetro discloses a method for partially verifying the legitimacy of a remote purchase request based on a card number from a card issuing financial institution comprising (a) receiving and storing a first purchase request information set including a card number and address information (column 2, line 63, through column 3, line 11); and (b) sending said card number and address information to said card issuing financial institution to determine if said address information matches an address on file for said card number

at said card issuing financial institution (column 3, lines 19-23; column 4, line 60, through column 5, line 18). Tetro discloses receiving and storing an electronic origin (column 3, lines 38-46; column 7, lines 39-61), but Tetro does not disclose sending the electronic origin to the card issuing financial institution to determine if the electronic origin matches an origin on file for the card number at said card issuing financial institution. However, Perlman teaches determining if the electronic origin of a would-be purchaser matches an origin expected for the corresponding card number (column 13, lines 26-49). Hence, it would have been obvious to one of ordinary skill in the art of business at the time of applicant's invention to send the electronic origin to the card issuing financial institution to determine if the electronic origin matched an origin on file for the card number at said card issuing financial institution, for the advantage, as stated by Perlman, of preventing fraudulent purchases.

As per claim 2, Perlman does not expressly teach receiving an indication of whether or not said electronic origin did match said electronic origin on file for said card number at said card issuing financial institution, but does teach that a credit card transaction is authorized or denied based on whether the electronic origin did match the expected origin, which would have to be on file to be expected (column 13, lines 26-49), from which it is inherent that an indication would have to be received.

As per claim 3, Perlman does not expressly teach said financial institution comparing said electronic origin to a file of origins associated to said card number, but does teach deciding whether to accept or reject a transaction based on whether the electronic origin corresponds to the expected electronic origin (column 13, lines 26-49),

from which it is inherent that at least one origin associated to the card number would have to be on file.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Various patents and other documents made of record in the parent case are hereby made of record in the present case, and may be pertinent for the reasons set forth in the two parent cases.

This is a continuation of applicant's earlier Application No. 09/513,608, now U.S. Patent 6,714,919, which is a division of applicant's earlier Application No. 09/017,403, now U.S. Patent 6,108,642. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft faxes can be sent to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nicholas D. Rosen

NICHOLAS D. ROSEN
PRIMARY EXAMINER

October 14, 2004